

Additionally, Claims 1, 2 and 4-7 have been rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 7 and 8 of U.S. Patent No. 6,936,395 to Goto et al. ("Goto '395").

With respect to Goto '064, Claims 1 to 6 thereof fail to recite that the image receiving sheet thereof includes a support. In this regard, it is clear that Claims 1 to 6 of Goto '064 fail to teach or suggest the image receiving sheet recited in Claim 1 of the present application.

Example 1 as disclosed in the specification of Goto '064 is relied upon to support the contention that the image receiving sheet disclosed in Claims 1-6 of Goto '064 includes a support. However, it is incorrect to rely on the teachings in the specification of Goto '064 to support a double patenting rejection, as Goto '064 is not considered prior art. *See*, MPEP § 804 (II)(B)(1). Claims 1, 2 and 4-7 of the present application are not merely an obvious variant of Claims 1-6 of Goto '064.

Similarly, with respect to Goto '395, Claims 1, 7, and 8 of Goto '395 fail to recite that the support thereof includes a polyethylene resin having the claimed MFR. In this regard, Claims 1, 7, and 8 fail to teach or suggest the image receiving sheet recited in Claim 1 of the present application.

Table 1 of Goto '395 is relied upon to support the contention that the image receiving sheet disclosed in Claims 1, 7, and 8 of Goto '395 has a support containing polyethylene. However, as described above, given that the specification of Goto '395 is not considered prior art, Table 1 is an incorrect basis to support a double patenting rejection. In this regard, Claims 1, 2

and 4-7 of the present application are not merely an obvious variant of Claims 1, 7, and 8 of Goto '395.

Reconsideration and withdrawal of the obviousness-type double patenting rejections are respectfully requested.

**II. Response to Claim Rejections - 35 U.S.C. § 102**

(A) Claims 1, 2 and 4-7 have been rejected under 35 U.S.C. § 102(f) allegedly because the applicant did not invent the claimed subject matter.

Goto '064 has been relied upon as purported evidence. The Examiner asserts that Goto '064 discloses subject matter identical to the present claims, but names inventors different from the inventors of the present application.

Applicants respectfully submit that Goto '064 does not disclose subject matter identical to the present claims. These reason are provided below in response to the rejection under 35 U.S.C. § 102(e) based on Goto '064.

(B) Claims 1, 2 and 4-7 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Goto '064.

Present Claim 1 recites that the toner image-receiving layer contains a thermoplastic resin in the form of a self-dispersing water-dispersible polyester resin emulsion which satisfies properties (1) to (4):

- (1) number average molecular weight ( $M_n$ ) = 5000 to 10000;
- (2) molecular weight distribution (weight average molecular weight/number average molecular weight)  $\leq 4$ ;
- (3) glass transition temperature ( $T_g$ ) = 40°C to 100°C; and
- (4) volume average particle diameter = 20 nm to 200 nm.

Goto '064 fails to inherently describe the water-dispersible polyester resin emulsion recited in Claim 1. To establish that the cited art inherently describes a claimed feature, the claimed feature must be necessarily present in the cited art. MPEP § 2112.

In the present case, Examples 2 and 4 of Goto '064 disclose producing a toner image receiving layer with a water-dispersed polyester resin KZA-7049 (Unitika). *See*, col. 22, Table 2. However, Comparative Example 2 of Applicants' specification describes that water-dispersed polyester resin KZA-7049 is a thermoplastic resin that fails to satisfy properties (1) to (4). As a result, the thermoplastic resins disclosed in Goto '064 do not necessarily satisfy properties (1) to (4) as recited in Claim 1.

(C) Claims 1, 2 and 4-7 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Goto '395.

Goto '395 is not prior art against the present application under 35 U.S.C. § 102(e). The present application claims foreign priority from JP 2002-283299 ("JP '299"), which was filed in Japan on September 27, 2002. Goto '395 has a filing date of February 19, 2003. Applicants submit herewith an English translation of JP '299 to remove Goto '395 as prior art.

### **III. Response to Claim Rejections - 35 U.S.C. § 103**

Claims 1, 2 and 4-7 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 5,824,462 to Ashida *et al.* ("Ashida '462") in view of U.S. Published Application No. 2002/0037176 to Ogino *et al.* ("Ogino '176"), U.S. Patent No. 5,885,698 to Takehana *et al.* ("Takehana '698") and U.S. Patent No. 6,444,383 to Ikekuchi *et al.* ("Ikekuchi '383").

Ashida '462 is deficient in that it fails to teach a water-dispersible polyester resin emulsion which satisfies properties (1) to (4) as recited in Claim 1. Ogino '176, Takehana '698, and Ikekuchi '383 are relied upon to make up for this deficiency in Ashida '462.

Claim 1 recites that the glass transition temperature is 40° C to 100° C.

In contrast, Ogino '176 teaches a polyester resin having a glass transition temperature Tg of about "30° C or less, preferably 15° C." *See*, paragraph [0122]. In this regard, Ogino '176 fails to make up for the deficiency in Ashida '462.

The mixture of NE382-1 and GK130 as disclosed in Ogino '176 would not necessarily provide for a glass transition temperature is 40° C to 100° C. Ogino '176 discloses that this mixture is an example of the polyester resin that has a glass transition temperature Tg of about 30° C or less, preferably 15° C. As such, Ogino '176 fails to make up for the deficiency in Ashida '462.

Furthermore, Claim 1 recites that the volume average particle diameter is 20 nm to 200 nm.

In contrast, Ogino '176 fails to teach the volume average particle diameter of its polyester resin. In this regard, it appears that Ogino '176 fails to teach or suggest that its polyester resin has a volume average particle diameter from 20 nm to 200 nm.

Takehana '698 teaches that its image-receiving layers 12 and 22 may include a polyester. *See*, col. 6, lines 24-29. Takehana '698 fails to teach the volume average particle diameter of its polyester. As such, it appears that Takehana '698 fails to teach or suggest that its polyester has a

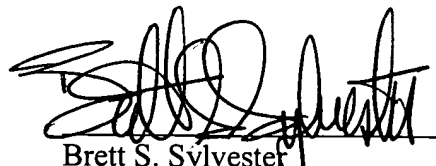
volume average particle diameter from 20 nm to 200 nm. As a result, Takehana '698 fails to make up for the deficiency in Ashida '462.

Ikekuchi '383 teaches that a polyester is used in the receptor layer of its image receiving sheet. *See*, col. 7, lines 26-28. Ikekuchi '383 fails to teach or suggest that the polyester thereof has a volume average particle diameter from 20 nm to 200 nm. As such, Ikekuchi '383 fails to make up for the deficiency in Ashida '462.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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